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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,139	08/10/2001	Marianne Langston	GJE-136D1	6929

23557 7590 09/24/2002

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EXAMINER

CHANG, CELIA C

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 09/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/928,139

Applicant(s)  
Langston

Examiner  
Celia Chang

Art Unit  
1625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 28, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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### DETAILED ACTION

1. Amendment and response filed by applicants in Paper No. 5, dated Feb.. 28, 2002 have been entered and considered carefully. New claim 8 was added. Claims 1-8 are pending.
2. The rejection of claims 1 and 5 under 35 USC 112 first paragraph is dropped in view of the amendment of the claims.
3. Applicants requested the acknowledgement of the receiving of the priority documents. It is noted that the parent application claimed benefit of provisional application 60/021,135 which was not of record to have foreign priority benefit. It is requested that records of filing and claiming such benefit under 35 USC 119 be made of record for this application. (See PALM record attached).
4. The rejection of claims (I) 1-3, 6 under 35 USC 103(a) over Shaflee in view of Barry or Miller; (ii) 1-6 under 35 USC 103(a) over Shaflee in view of Barry or Miller further over Rometsch; (iii) 1-7 under 35 USC 103(a) over Shaflee in view of Barry or Miller further over Rommetsch and Jacques supplemented with Harris; are maintained for reason of record. These rejections are also applicable to the newly added claim 8.

The gist of applicants argument is that references taken alone or in combination do not rendered the claims obvious because the instant claims are drawn to racemization of compounds having two stereogenic centers while the references have only one chiral center and do not teach or suggest two stereogenic center. This is erroneous. To the extend that the two stereogenic centers are from methylphenidate and the "resolution agent" (see p.2 specification) then it is noted that Shaflee disclosed the *very same* two stereogenic center (see p.267, right column compound 9, stereogenic methylphenidate, stereogenic resolution pheniramine with achiral acid) as well as Miller '261, col. 4 example 2, amino adipic acid wherein two stereogenic center are

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found in the salt (line 54). The employing of a carboxylic acid of newly added claim 8 was also delineated in the previous office action (see p.2, section 3, Barry used acetic acid).

In obviating a prima facie case of obviousness factual evidence indicating unexpected disclosed merits should be support instead of mere arguments. In re Lindner 173 USPQ 356.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

WP/Chang  
Sep. 18, 2002

  
Celia Chang  
Primary Examiner  
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